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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,654	01/07/2002	Victor N. Vu	42390P12319	2691

7590 05/23/2005

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EXAMINER

COURTENAY III, ST JOHN

ART UNIT	PAPER NUMBER
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2194

DATE MAILED: 05/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,654

Applicant(s)

VU, VICTOR N.

Examiner

St. John Courtenay III

Art Unit

2194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-15,17,18,20-23,25-27,29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-10,13-15,17,23,25-27,29 and 30 is/are allowed.
- 6) ☒ Claim(s) 18 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 20050516.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.


ST. JOHN COURTENAY III
PRIMARY EXAMINER

Response to Amendment

Objection to the claims:

Claim 12 depends upon cancelled claim 11.
Appropriate correction is required.

Responsive to newly revised PTO Group 2100 examination guidelines, new grounds of rejection are set forth below under 35 U.S.C. §101.

The new §101 guidelines are promulgated under agency authority (i.e., not based primarily on existing case law) and are mandatory. Absent an amendment to limit the scope of the claimed subject matter to a **tangible** machine-readable medium, the Examiner does not have discretion to waive or withdraw the rejections set forth below.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful **process, machine, manufacture, or composition of matter**, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Independent claim 18 recites:

"A machine readable medium having stored thereon data representing sets of instructions, the sets of instructions which, when executed by a machine, cause the machine to:"

Such language in the preamble would normally be considered statutory unless the specification defines "machine readable medium" as including intangible media such as signals, carrier waves, transmission, optical waves, transmission media, or other

media incapable of being touched or perceived absent the tangible medium through which they are conveyed.

In the instant application, the claimed "machine-readable medium" is supported on page 6 of the specification by the following language:

[0016] Moreover, the present invention may also be downloaded as a computer program product, wherein the program may be transferred from a remote computer (e.g., a server) to a requesting computer (e.g., a client) by way of data signals embodied in a carrier wave or other propagation medium via a communication link (e.g., a modem or network connection). Accordingly, herein, a carrier wave shall be regarded as comprising a machine-readable medium.

In light of Applicant's definition (above), independent claim 18 and associated dependent claims 20, 21, and 22 are not limited to tangible embodiments. Accordingly, under the new PTO 35 U.S.C. §101 examination guidelines, the claim is not limited to statutory subject matter and is therefore non-statutory.

Claims 18, 20-22 are rejected under 35 U.S.C. 101 because the claimed invention, as not being tangibly embodied in a manner so as to be executable, is not supported by either a specific and substantial asserted utility (i.e., transformation of data) or a well established utility (i.e., a practical application).

35 U.S.C. § 112, 1st paragraph

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18, 20-22 are also rejected under 35 U.S.C. 112, first paragraph. Since the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility for the reasons set forth above, one skilled in the art would not know how to use the claimed invention.

35 U.S.C. § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999). See also Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

Claims 18, 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are computer hardware necessary to execute the claimed software and render the invention operative. The preamble of claim 18 is a statement of purpose or intended use, i.e., "instructions, which, when executed by a machine, cause the machine to:" The "machine" recited in the preamble is therefore part of a statement of intended use and is not accorded weight as a claim limitation.

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Indication of Allowable Subject Matter:

Responsive to Applicant's amendments and supporting arguments, and subject to a final search and removal of the objection to dependent claim 12, (see above), independent claims 1, 10, 14, 23 and 27 and associated dependent claims appear to be allowable over the prior art of record.

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How to Contact the Examiner:

Any inquiry concerning this communication or earlier communications from the examiner should be directed to St. John Courtenay III, whose telephone number is 571-272-3761. A voice mail service is also available at this number. The Examiner can normally be reached on Monday - Friday, 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-AI who can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

All responses sent by U.S. Mail should be mailed to:

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**PTO CENTRAL FAX NUMBER:
703-872-9306**

- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (571) 272-2100.**


ST. JOHN COURTENAY III
PRIMARY EXAMINER